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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,479	05/18/2001	Gou Yamazaki	016891-0835	4543

22428 7590 09/09/2004

FOLEY AND LARDNER
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EXAMINER

BATURAY, ALICIA

ART UNIT PAPER NUMBER

2155

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,479

Applicant(s)

YAMAZAKI, GOU

Examiner

Alicia Baturay

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 1, 4 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/859,479.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/1/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-9 are pending.

Specification

2. The abstract of the disclosure is objected to because of grammatical errors. Applicant states "a message consignor transmits messages..." It is suggested that this sentence read "A message consignor that transmits messages which include recipient information, and a timestamp with the date and time that the message is to be sent." Additionally, "...via a telephone network if an attribute of the message is voice or via the Internet if an attribute of the message is an email" can be rewritten as "The message will be sent via a telephone network if the message is a voice mail or via the Internet if the message is an e-mail." These corrections are exemplary and further corrections within the abstract are required. See MPEP § 608.01(b).
3. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Objections

4. Claims 1, 4, and 7 are objected to as being unspecific. The use of the phrase "day/hours information" should be correct to "date and time."

5. Claim 3 is objected to because of the following informalities: Applicant states "said storage device stores, in association with said man message..." It is thought Applicant meant to say "main message." Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-9 are unpatentable under 35 U.S.C. 102(b) as being anticipated by Gordon (U.S. 5,608,786).
8. As to claim 1, Gordon describes a system for communicating messages comprising: a receiving device for receiving messages via a telephone network or the Internet (col. 1, line 66 – col. 2, line 17), a storage device for storing messages (col. 2, lines 32-36) and a transmission device for transmitting messages out of the storage device (col. 1, lines 6-10). Messages are shown as passing through the UniPost Access Node (Fig. 1, element 6) before being transmitted, it is therefore inherent that storage of the message on the server takes place before transmission. Gordon also discloses message recipient information regarding the intended recipients (col. 2, lines 4-11) and information regarding the date and time for communicating the message (Figure at col. 10, lines 37-49, titles "Date" and "Time").

9. As to claim 2, Gordon discloses the invention as described in claim 1, including voice-to-text (col. 6, lines 56-58) and text-to-voice (col. 5, lines 8-9) conversions.

10. As to claim 3, Gordon discloses the invention as described in claim 1, including transmission of distinguishing information for identifying another message related to said main message (col. 10, lines 64-65). Message forwarding indicates that a voice or text message is being forwarded (by attaching a "Fwd:" within the subject of an email or by a built-in automatic announcement that the message was forwarded via voice mail) and a user is able to add comments in addition to the forwarded message. Therefore, it is inherent that this function distinguishes a message that is related to the main message.

11. As to claims 4 and 7, claim 1 is a system performing the same functions as claims 4 and 7. Therefore, paragraph 8 of this Office Action discloses all of the limitations of claims 4 and 7.

12. As to claims 5 and 8, claim 2 is a system performing the same functions as claims 5 and 8. Therefore, paragraph 9 of this Office Action discloses all of the limitations of claims 5 and 8.

13. As to claims 6 and 9, claim 3 is a system performing the same functions as claims 6 and 9. Therefore, paragraph 10 of this Office Action discloses all of the limitations of claims 6 and 9.


Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (703) 305-8865. The examiner can normally be reached on 7:15am - 3:45pm, Monday - Friday. The examiner will be moving in mid-October and can be reached then at (571) 272-3981. The Tech Center main telephone number will be (571) 272-2100.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER